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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,177	12/12/2001	Hans-Detlef Arntz	Mo-6837/LcA 33,565	8533
157	7590	12/12/2003		
BAYER POLYMERS LLC 100 BAYER ROAD PITTSBURGH, PA 15205			EXAMINER SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,177

Applicant(s)

ARNTZ ET AL.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Claims 12, 13, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Adequate support has not been provided for the amendment to claim 12 specifying the sum of the mole percents.
2. Claims 11-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants have relied upon a foreign test standard to set forth the oil and petroleum resistance of the composition. Neither have applicants established that the foreign standard correlates to a U.S. standard, such as ASTM, nor have applicants provided English documentation describing the standard; therefore, adequate enablement has not been set forth for claim limitations pertaining to the standard.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 11, 15, 17-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mao ('572).

Patentee discloses the production of flexible polyurethanes, suitable for use in coating, automotive, and fabric coating applications, wherein the polyurethane is produced from a 70:30 to 90:10 weight ratio blend of 1,000-3,000 molecular weight polyether polyol and 1,000-3,000 molecular weight polyester polyol. See columns 2 and 3 and examples. Despite applicants' response, patentee discloses an index ratio that anticipates applicants' claimed ratio. See column 3, lines 53-58 and column 4, lines 54 and 55. Since the disclosed polyurethanes and claimed compositions are produced from equivalent reactants in overlapping ratios, the position is taken that it is logical to conclude that the disclosed polyurethanes inherently possess the same properties as the claimed polyurethanes.

5. Applicants' response has been considered; however, the response is not found persuasive. Firstly, with respect to the claimed index ratio, the disclosed range falls within the claimed range and is, therefore, anticipatory of the claimed range. See MPEP 2131.03. Secondly, applicants'

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argument with respect to the relative amounts of polyol mixture and chain extender is not commensurate in scope with the claims. The claims set forth no language that governs the relationship between the polyol and the chain extender. Lastly, with respect to the claimed amount of polyester, the position is taken that column 3 and the examples of the reference disclose the claimed amount of polyester with sufficient specificity to render the disclosure anticipatory.

6. Claims 14, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mao ('572).

As aforementioned, Mao discloses the production of polyurethanes, suitable for the production of coatings and moldings, comprising reactants which meet those claimed by applicants; however, Mao is silent regarding the use of the polyurethanes to produce shoe soles and tubing. Still, the position is taken that the production of both shoe soles and tubing from moldable polyurethanes was well known at the time of invention; therefore, the position is further taken that it would have been obvious to produce such conventional articles from the disclosed polyurethane compositions. Furthermore, though Mao is silent regarding the initial combination of the polyester component with the polyisocyanate, the position is taken that it would have been obvious to create an initial admixture of polyisocyanate and one of the polyol components, so as to compatibilize the polyisocyanate within the composition, by such means as prepolymerization, or to control compatibility problems that could arise from admixing the respective polyol species.

7. Despite applicants' argument, the examiner has set forth a reasonable rationale as to why the subject matter of the claims is considered to be obvious.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
December 8, 2003


RABON SERGENT
PRIMARY EXAMINER